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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,172	03/19/2002	Masatoshi Kobayashi	112044	7545
7590	08/23/2004		EXAMINER	
Oliff & Berridge PO Box 19928 Alexandria, VA 22320			BROCKETT, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,172

Applicant(s)

KOBAYASHI ET AL.

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02222002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings were received on June 22, 2004. These drawings are approved.

Claim Objections

Claims 24-28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. At first glance claims 24-28 appear to be dependent claims since they reference another claim in the limitations. However, the claims are directed towards a separate invention, i.e. a computer-usable storage medium. Therefore, they do not further limit the subject matter of a previous claim. For example, in claim 24, the limitations of claim 1 are merely being incorporated into a the storage medium (through a short-hand method by referencing claim 1) and it is the storage medium that is being further limited by the additional claim language, not the device of claim 1. Consequently, claim 1 is not being further limited by the limitations of claim 24. While the short-hand way of writing the claim is acceptable. The claim is independent and the necessary fees associated with independent claims must be paid. See MPEP 608.01(n)

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which states: "Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.) The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any *necessary* additional fee."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 24-28 all recite “A computer-usable information storage medium used in a game system that comprises: the position indication device as defined by claim #...” A computer-usable storage medium is a disk, CD, hard drive, memory, etc. These types of devices are not capable of comprising a position indication device as defined in the other claims. A storage device holds computer data, for example a program or files, not a position indication device. Furthermore, storage mediums also cannot contain game processing means or image generation means as recited in the claims. Therefore, the claims are not enabled. The Examiner believes that Applicant intended the claim to recite: “A game system that comprises: a computer-usable information storage medium...” in which case the claim would be enabled if re-written in this manner.

Allowable Subject Matter

Claims 1-23 are allowed over the prior art of record.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record lacks in disclosing a cut-out portion in a connection portion between parts of the light-proof member in order to form a through-hole for a signal terminal of the optical sensor. The prior art also lacks in disclosing a second light-proof member to prevent the incidence of the external light from a gap between the board and a slit provided in the light-

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proof member for the insertion of the board. Furthermore as pointed out in Applicant's arguments, the closest prior art of record, Fujimoto, does not disclose a light-proof member that is provided in the indicator body and covers the lens and the optical sensor completely in such a manner that external light other than light from the light-incident aperture is not incident on the lens and the optical sensor. Fujimoto provides a filter that allows infrared light through it. Therefore, the filter is not a light-proof member that completely covers the lens and optical sensor so that external light is not incident on these elements.

Response to Amendment

It has been noted that claims 1, 5, 12, 22 and 23 have been amended. New claims 25-28 have been added.

Response to Arguments

Applicant's arguments, see Arguments, filed June 22, 2004, with respect to the Fujimoto reference and claims 1-23 have been fully considered and are persuasive. The rejection of claims 1-23 has been withdrawn.

Based on Applicant's submission of the International Search Report, references JP 53-143500 and JP U 63-89141 from the IDS statement filed February 22, 2002 have been considered.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Julie K Brockett
Examiner
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